

## REMARKS/ARGUMENTS

This Response is promptly filed to place the above-referenced case in condition for immediate allowance.

The status of the claims is as follows:

Cancelled: None;

Amended: None;

Added: None; and

Currently outstanding: 1 – 8, 12, 14 – 92.

### **In Response to the Omissions Letter of May 11, 2005**

The Examiner transmitted an Office communication dated May 11, 2005 indicating that the reply filed on 25 February 2005 is not fully responsive as Applicant omitted arguments specific to the newly claimed subject matter in Claims 29 – 36, 41 – 43, 50 – 52, 60 – 62, 69 – 71, 78 – 80, and 88 – 90.

All of these claims are dependent claims and the claims are generally directed to the inclusion of buyer preferences, receiving product preference information from the buyer, and ordering products for the buyer using the preference information.

The newly claimed subject matter is believed not to be present in the cited prior art, is believed to be supported by Applicant's specification, and is believed to define patentable subject matter over the prior art. Consequently, according to 37 C.F.R. § 1.111, Applicant believes that these specific distinctions render the claims patentable over the applied references.

**In Supplemental Response to the Office action of October 21, 2004**

No new matter has been added to the application.

From the outstanding Office action: The Examiner rejected Claims 1 – 4 and 13 – 15 under 35 U.S.C. 101; and Claims 1 – 8 and 12 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Hall et al. '375 patent in view of the Stevens '758 patent.

Reconsideration is respectfully requested.

Applicant believes the remarks below will aid the Examiner in understanding the Hall et al. '375 patent in the context of the present application and the reasons why it does not provide a disabling disclosure either for anticipation or obviousness purposes.

In the Hall '375 patent, the definition of the beginning and the end of a travel route is never disclosed. Nor does the Hall patent disclose how to build or determine such a travel route. The only place in Hall's patent that ever mentions the "route" concept is at col. 9, lines 27-30, where it states, "Preferably, the local facility is the facility nearest geographically to the customer's location at the time of the order or a facility that is convenient to the customer's planned travel route, such as the way home from work."

Because of this, Applicant believes that what has been disclosed in the Hall patent with regards to the implementation of a "planned route" is far from workable because Hall fails to disclose the important factors in formulating a travel route, namely, allowing the user to define the beginning and the end of the route. Based on these reasons, Applicant believes that the only route that a Hall-type system can formulate is the route the user has traveled. This means that the route that Hall can formulate is retrospective and not prospective. Consequently, a

Hall-type system does not disclose subject matter that anticipates or makes obvious Applicant's claims.

However, even if the "planned route" concept is taught or implied by the Hall '375 patent, Applicant's system is still patentable over Hall for the following reasons:

A) Hall's system and Yang's system each solves different problems and should be patentable as per In re Wright, 6 USPQ 2d 1959 (1988). There, the court stated as it reversed a rejection based on obviousness that, "[t]he problem solved by the invention is always relevant." Id. at 1962.

The Hall '375 patent solves the problem for a buyer who places an order in a "mobile environment", i.e., when traveling (see at least col. 1, line 7). To satisfy the order, the server determines the buyer's current location and traveling speed, and searches for a local facility to produce the order. The local facility makes use of the time when the buyer is traveling to the local facility to prepare the order so that when the user arrives at the local facility, the order is ready for pickup. Because of this, the server needs to know where the buyer is and the buyer's traveling speed when placing the order.

The Yang system of the instant application solves the problem for a buyer who is not in a "mobile environment" when placing an order. The user may place an order from his/her home, in his/her office, and not necessarily in his/her car. The order does not have to be placed when he/she is driving (in a "mobile environment") and may be placed days or weeks before traveling. The order may not need to be produced by a pick up location (the Yang counterpart of Hall's local facility). The order may be shipped to a pickup location from a

warehouse and wait to be picked up. The order arrives at a local pick up location at a predetermined time known to the buyers and is then ready to be picked up. The buyer can arrive anytime at the pick up location during a predetermined time period and pick up the order. Since the order is already at the pickup location, the system does not have to estimate the buyer's arrival time to prepare the order. Nor does the seller need to know where the buyer is nor the buyer's driving speed when the buyer places the order.

In Yang's system, an order has already been prepared when it leaves the server warehouse or store. So, in Yang's business system, these procedures that are essential in Hall's invention such as: tracking the user's current location and speed, inquiring of the inventory level of local facilities, estimating the preparation time at the local facility, estimating user's arrival time to the facility and searching for such a facility along with the equipment and manpower to facilitate such procedures, are all unnecessary. This is because in Yang's system, no preparation time in the local facility is needed. Also, when the order has been delivered to a local facility (or pickup location) and stays there for a determined period of time known to the user, the user may just come to the pickup location to pick it up. The order is ready for the buyer. All the above procedures related to the Hall system are unnecessary.

Further, in the case where a common section of travel routes is shared by many different users, Yang's system may institute only one single pickup location along the shared section and all users can go to this pickup location to pickup their orders. In this case, one pickup location may take care of all orders. Operation costs are thus saved. But because different orders involve different preparation time and different users travel at different speeds and may place orders at different locations, instituting only one local facility may not work in

Hall's system. This is true even though all users use exactly the same route. So, Hall's system requires more local facilities than Yang's system to operate. Also, these capital investments spent on tracking user's current location when placing orders produces no benefit to Yang's business and is wasteful. So, uses of Hall's system in Yang's system creates unnecessary spending and thus render it less efficient. By the same token, a system that can be operated with Yang's system cannot be operable within Hall's system.

Also, because in the Yang system, orders are ready before being picked up by an MPS and do not need to be produced by a local facility (or pickup location), Yang's MPS service can be expanded as follows: An MPS server may go to many other sellers and pick up many orders and ship these orders back to an MPS warehouse for grouping and then ship these orders to a pick up location for pickup. In this scenario, a server may pick up products from multiple sellers and deliver these products (the buyer's orders) to a pick up location operated by the server. Note that not all of these products are produced by the server and, in one delivery, the orders are all delivered at the pick up location and the whole transaction is completed. There is no way a Hall-based server can complete such a transaction.

Since there are significant distinctions in Yang's and Hall's systems (or Hall's system and Stevens's system combined), Yang's claims should be patentable.

The above argument is true even if Yang's pickup location is a Fixed Pickup Location as claimed by claims 37-54 and claims 73-92.

B) There are fundamental differences in the Stevens box and the Mobile Pickup Station in Yang's system.

In Yang's system, an MPS is removed back to an MPS warehouse for reloading after the station time is over or after all users receive their orders. The MPS is reloaded and is sent out to a pick up location for the next delivery. In Stevens, the Stevens box is a storage unit. The Stevens box stays at the user's premises even after the order has been received by the buyer and withdrawn from the box. This is also true when a "stackable locker" is involved. In Stevens's invention, a "stackable locker" is used when the buyer's original box can not handle the shipment. A stackable box is a back up box used in the event a customer receives too many deliveries to fit into a single locker (Stevens col. 1, lines 21-23). Even with the "stackable locker", at least one Stevens locker box is fixed at the user premises (see, at least, Stevens col. 1, lines 24-25). This not the case with Yang's MPS.

For all these reasons, and the reasons set forth in the last Reply, Applicant believes that the instant claims overcome the Examiner's rejections.

In view of the above, the Examiner is respectfully requested to reconsider his position in view of the remarks made herein and the distinctions now set forth. The Examiner's rejections of the outstanding claims are believed to no longer apply. It is now believed that this application has been placed in condition for allowance, and such action is respectfully requested. Prompt and favorable action on the merits is earnestly solicited. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

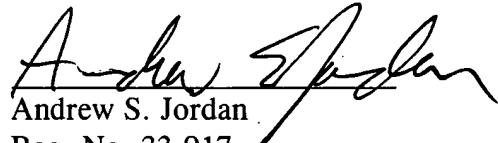
The statements made herein with respect to the disclosures in the cited references represent the present opinions of the undersigned attorney. In the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective references providing the basis for a contrary view.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at the number listed below.

With the above-referenced changes, it is believed that the application is in a condition for allowance; and Applicant respectfully requests the Examiner to pass the application on to allowance. It is not believed that any additional fees are due; however, in the event any additional fees are due, the Examiner is authorized to charge Applicant's Attorney's Deposit Account No. 03-2030.

Respectfully submitted,

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Date: June 3, 2005

DMC/ASJ/kr

Enclosure

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PATENT

Appl. No. 10/055,144

Ammdt. dated June 3, 2005

Reply to Office action of Oct. 21, 2004

03-12863

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6/3/05

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June 3, 2005